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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,508	11/03/2000	Michael Schwartz	JUR-PT001	6522
3624	7590	02/24/2005	EXAMINER	
VOLPE AND KOENIG, P.C. UNITED PLAZA, SUITE 1600 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103			TRAN, TUAN A	
			ART UNIT	PAPER NUMBER
			2682	

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,508

Applicant(s)

SCHWARTZ ET AL.

Examiner

Tuan A Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 38-49 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Examiner's Answer.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/706,508
Filing Date: November 03, 2000
Appellant(s): SCHWARTZ ET AL.

Jeffrey M. Glabicki
For Appellant

EXAMINER'S ANSWER

MAILED

FEB 24 2005

Technology Center 2600

This is in response to the appeal brief filed 11/08/2004

(1) Real Party in Interest

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A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejections of claims 38-49 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

US 6,230,029	Overy et al.	May-2000
US 2002/0094787	Avnet et al.	July-2002
GB 2214740	Edmonds	June-1989

(10) New Prior Art

The following is a listing of the prior art of record not relied upon in the rejection of claims under appeal.

US 5,943,627	Kim et al.	August-1999
US 6,459,882	Palermo et al.	Oct-2002

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hahn et al. (6,230,029).

Regarding claim 38, Hahn discloses a communication device (See fig. 3) comprising: a speaker 24 configured to direct sounds towards an ear canal of a listener's ear and a module 24 configured to fit to the listener's ear; a housing connected to the speaker module 24, the housing configured to be substantially supported by a pinna of the listener's ear and containing substantially all other components of the communication device other than the speaker (See figs. 3 and col. 2 lines 45-50, col. 5 lines 43-57). However, Hahn does not mention that the speaker module configured to fit substantially in a concha portion of the listener's ear. Official Notice has been taken by the Examiner that the speaker module of a headset having a size that can be fitted in a concha portion of the listener's ear is very common in the art; therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the speaker module as disclosed by Hahn with the size that can be fitted in the concha portion of the ear for the advantage of allowing greater customization in the fitting of the headset module to the user's ear

Regarding claim 40, Hahn discloses as cited in claim 38. Hahn further discloses the all other components comprises a tuned frequency of the tuner 30 is adjustable by a listener and inherently a variable frequency tuner (See fig. 10).

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2. Claims 38-39 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edmonds (GB 2214740) in view of Hahn et al. (6,230,029).

Regarding claims 38-39, Edmonds discloses a portable radio receiver distributed for individuals for receiving a preexisting public available broadcast (See fig. 3 and Abstract), the radio comprising: a receiver for receiving only the preexisting public available broadcast, the receiver is fixedly set to receive the preexisting public available broadcast; and a speaker for producing audio signals of the received preexisting public available broadcast (See fig. 3 and abstract, pages 1-2). However, Edmonds does not mention that the portable radio receiver comprises: a speaker configured to direct sounds towards an ear canal of a listener's ear and a component configured to fit substantially in a concha portion of to listener's ear; a housing connected to the component, the housing configured to be substantially supported by a pinna of the listener's ear and containing substantially all other components of the communication device other than the speaker. Since Hahn teaches a wireless transceiver headset (See fig. 3) comprising: a speaker 24 configured to direct sounds towards an ear canal of a listener's ear and a module 24 configured to fit to the listener's ear; a housing connected to the speaker module 24, the housing configured to be substantially supported by a pinna of the listener's ear and containing substantially all other components of the communication device other than the speaker (See figs. 3 and col. 2 lines 45-50, col. 5 lines 43-57) and Official Notice has been taken by the Examiner that the speaker module of a headset having a size that can be fitted in a concha portion of the listener's ear is very common in the art; therefore it would have been obvious to one

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of ordinary skill in the art at the time the invention was made to replace a hand held wireless communication device with a wearable wireless communication device for the advantage of giving the user higher degree of freedom (hand free) as well as to configure the speaker module as disclosed by Hahn with the size that can be fitted in the concha portion of the ear for the advantage of allowing greater customization in the fitting of the headset module to the user's ear.

Regarding claims 42-44, Edmonds & Hahn discloses as cited in claims 38-39. However, they do not mention that the device comprises indicia of the preexisting public available broadcast or an advertiser/sponsor of the preexisting public available broadcast. Official Notice has been taken that displaying indicia of the preexisting public available broadcast or an advertiser/sponsor of the preexisting public available broadcast on the device is a well known graphical presentation technique such as all Disney TV broadcast programs or products having Disney logo or handheld/car radios displaying radio station channel: FM 107.3, FM 104.1, AM 1500 ... etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included indicia of the preexisting public available broadcast or an advertiser/sponsor of the preexisting public available broadcast on the device for the advantage of allowing the advertiser/sponsor to sell their names to the customers for commercial purposes.

3. Claims 41 and 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edmonds (GB 2214740) in view of Hahn et al. (6,230,029) as applied to claim 38 above, and further in view of Avnet et al. (2002/0094787).

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Regarding claims 41 and 45-48, Edmonds & Hahn disclose as cited in claim 38. However, they do not mention that the communication device is a digital recording player comprising: a digital audio processor, a memory (ROM and RAM) and an input for receiving, storing and producing an audio signal of a digital recording. Avnet suggests a portable (hand held) communication device 16, associated with a predetermined broadcast of a predetermined information delivery system 18 wherein the communication device is a digital recording player inherently comprising: a digital audio processor, a memory (ROM and RAM) and an input for receiving, storing and producing an audio signal of a digital recording (See page 2 and page 3 [0023-0024]). Since both Edmonds & Hahn and Avnet teach about devices for receiving only a predetermined broadcast; therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to follow Avnet's suggestions in modifying the device as disclosed by Edmonds & Hahn for the advantage of expanding the capability of the system to various additional operational functions such as playback in order to accommodate the user's intentions.

Regarding claim 49, Edmonds & Hahn & Avnet disclose as cited in claim 45. Avnet further discloses an indicia is associated with the digital recording (See page 1 [0008]).

(12) Response to argument

With respect to appellant's remarks filed November 08, 2004, the responses are as follows:

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a. The Appellant argued that “the Hahn apparatus does not have any component fitting into the concha or, in particular, fit substantially in a concha” (See Appeal Brief, Argument section, page 7 third paragraph). The Examiner have acknowledged in the Final Office Action mailed 07/30/2004 that Hahn does not mention (explicitly in writing) the speaker module configured to fit substantially in a concha portion of the listener’s ear. As disclosed in the rejection, the speaker module of the Hahn apparatus configured to fit to the listener’s ear (See Hahn, col. 5 lines 54-57) and Official Notice has been taken by the Examiner that the speaker module of a headset having a size that can be fitted in a concha portion of the listener’s ear is very common in the art, example of such shown by Kim (See fig. 2 and col. 3 lines 36-37) or Palermo (See fig. 3 and col. 2 lines 25-27, col. 3 lines 38-40); therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the speaker module as disclosed by Hahn with the size that can be fitted in the concha portion of the ear for the advantage of allowing greater customization in the fitting of the headset module to the user’s ear.

b. The Appellant argued that “ with respect to Hahn, the pinna does not bear the weight of the housing” (See Appeal Brief, Argument section, page 7 fourth paragraph). The Examiner respectfully disagrees with the Appellant’s argument because the housing of the Hahn apparatus is **configured to be substantially supported** by a pinna of the listener’s ear (See Hahn, fig. 3 and col. 5 lines 43-57 and fig. 3 presented by the Appellant in the Argument section of the Appeal Brief)

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

WAW

Tuan Tran

February 18, 2005

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